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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------|-------------|----------------------|---------------------|------------------|
| 09/954,807 | 09/12/2001 | Irwin Jerold Singer | 17037B | 8210 |
| 23556 | 7590 | 08/25/2004 | | |
| KIMBERLY-CLARK WORLDWIDE, INC. | | | | |
| 401 NORTH LAKE STREET | | | | |
| NEENAH, WI 54956 | | | | |
| | | | EXAMINER | |
| | | | AUGHENBAUGH, WALTER | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1772 | |

DATE MAILED: 08/25/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

August 19, 2004

Application Number: 09/954,807
Filing Date: September 12, 2001
Appellant(s): SINGER ET AL.

Robert A. Ambrose
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 24, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: claim 28 does not stand rejected under 35 U.S.C. 103 over Midkiff in view of Drew as stated on page 2 of Appellant's brief under the "The Issues Presented" heading. Claims 13-26 and **29**-31 stand rejected under 35 U.S.C. 103 over Midkiff in view of Drew as made of record in paragraph 14 of Paper 10.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellant's arguments presented in the brief regarding the rejection of claim 28 under 35 U.S.C. 103 depend entirely upon Appellant's

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arguments presented in the brief regarding the rejection of claims 1-11 under 35 U.S.C. 102. Claims 1-11 and 28 therefore stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|---------|--------|
| 5,667,562 | Midkiff | 9-1997 |
| 6,186,320 | Drew | 2-2001 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Midkiff.

In regard to claim 1, Midkiff teaches a spunbond nonwoven web comprising thermoplastic fibers useful as a protective web or as a component of diapers or feminine hygiene products (col. 1, lines 4-22 and col. 2, lines 30-55); therefore, Midkiff teaches that the spunbond nonwoven web is a sensitive surface protective material for protecting a sensitive surface of an article. Any protective web is a protective material that protects a surface of an article that is sensitive to something. Midkiff teaches that the web has bonds at almost every fiber crossover point (col. 7, lines 55-57); therefore, Midkiff teaches that the nonwoven web is bonded with a pattern having continuous bonded areas defining a plurality of discrete unbonded areas. Midkiff teaches that the web is electret treated so that particles are electrostaticly drawn toward the web (col. 8, lines 5-32). Since Midkiff teaches that particles are electrostaticly drawn toward the web, the sensitive surface

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protective material taught by Midkiff protects a sensitive surface from damage caused by particles by attracting the particles to the electret treated spunbond nonwoven web, and therefore, away from the sensitive surface. The phrase “for protecting a sensitive surface of an article” is an intended use phrase that has been given little patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). The second recitation of “sensitive surface” in the claim 1 (fifth line) has also been given little patentable weight since the recitation “the sensitive surface” (fifth line of claim 1) refers to the “sensitive surface” recited in the intended use phrase.

In regard to claims 2-8, Midkiff teaches that the thermoplastic fibers comprise monocomponent fibers, multicomponent fibers or bicomponent fibers comprising a first polymer component and a second polymer component (the term “filament” as claimed is equivalent to the term “fiber” as Midkiff uses in the passages cited in this sentence), and that polypropylene and polyethylene are particularly suitable polymers used to make the fiber components (col. 3, lines 39-57 and col. 6, lines 56-60). Midkiff teaches that the polymeric components are configured in a side-by-side arrangement or a sheath/core arrangement wherein one polymer component is surrounded by another (and therefore wherein the sheath comprises the first polymer component and the core comprises the second polymer component as claimed in claim 8) (col. 3, lines 47-51).

In regard to claims 9 and 10, Midkiff teaches that the Gurley stiffness of the nonwoven web is at least 20mg (col. 2, lines 7-12), a range that overlaps with the ranges of less than about 80mg and about 15mg to about 75mg claimed in claims 9 and 10.

In regard to claim 11, Midkiff teaches that the nonwoven web is charged to about 1 kVDC/cm to 12 kVDC/cm (col. 8, lines 25-28), a range that overlaps with the claimed range of about 1 kVDC/cm to about 20 kVDC/cm.

Claim Rejections - 35 USC § 103

Claims 13-26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midkiff in view of Drew.

Midkiff teaches the electret treated spunbond nonwoven web as discussed above.

In regard to claim 13, Midkiff fails to teach a storage sleeve for holding an article having a sensitive surface to protect the sensitive surface from damage comprising a first web and a second web comprising the electret treated spunbond nonwoven web of Midkiff interconnected with the first web to form a pocket to hold the article having a sensitive surface.

Drew, however, in regard to claims 13 and 16, discloses a storage sleeve comprising a first sheet (item 16) and a third sheet (item 14) and a spunbonded nonwoven polypropylene-fiber protective second sheet (item 18) positioned between the first and third sheets, where the first, second and third sheets are interconnected together at least on the bottom edge and two side edges to form a first pocket between the first and second sheets and to form a second pocket between the third and second sheets wherein compact discs (an article having a sensitive surface as claimed) are placed and the playing sides (the sensitive surface of the article having a sensitive surface as claimed) of the compact disks are in contact with the protective nonwoven sheet so that the playing surface of the compact disk is protected (col. 1, lines 41-54 and 63-65, col. 2, lines 6-13 and 39-43, col. 3, lines 42-66 and Figures 1-12; col. 5, lines 15-39). One of ordinary skill in the art would

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have recognized to have replaced the protective spunbonded nonwoven sheet of Drew with the electret treated spunbond nonwoven protective web of Midkiff so that the protective second sheet of the storage sleeve of Drew electrostaticly attracts particles as taught by Midkiff in order to enhance the protective capability of the protective second sheet of the storage sleeve of Drew.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the protective spunbonded nonwoven sheet of Drew with the electret treated spunbond nonwoven protective web of Midkiff so that the protective second sheet of the storage sleeve of Drew electrostaticly attracts particles as taught by Midkiff in order to enhance the protective capability of the protective second sheet of the storage sleeve of Drew.

In regard to claims 14-15 and 17-18, Drew disclose that the first and third sheets are made of polypropylene (col. 3, lines 57-62); the first and third sheets are therefore polypropylene films.

The limitations of claims 19-22 and 24-26, which are directed entirely to the electret treated spunbond nonwoven web, were addressed in the rejection of claims 2-11 provided in this Office Action (Paper #10).

In regard to claim 23, which, when considered with claim 21 upon which claim 23 depends, claims that the sheath comprises polyethylene and that the core comprises polypropylene, Midkiff teaches that the thermoplastic fibers comprise bicomponent fibers comprising a first polymer component and a second polymer component (the term "filament" as claimed is equivalent to the term "fiber" as Midkiff uses in the passages cited in this sentence), that polypropylene and polyethylene are particularly suitable

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polymers used to make the fiber components (col. 3, lines 39-57 and col. 6, lines 56-60) and that the polymeric components are configured in a sheath/core arrangement wherein one polymer component is surrounded by another (col. 3, lines 47-51). Since the arrangement of the polyethylene and polypropylene components in the sheath/core arrangement is not limited by the disclosure of Midkiff, the arrangement where the sheath comprises polyethylene and the core comprises polypropylene is included in the disclosure of Midkiff and is therefore taught by Midkiff.

In regard to claims 29 and 30, Midkiff and Drew teach the storage sleeve as discussed above. Since Drew teaches that compact discs are placed in the first pocket between the first and second sheets and the second pocket between the third and second sheets and that the playing sides of the compact disks are in contact with the protective nonwoven sheet so that the playing surface of the compact disk is protected as discussed above in the rejection to claim 13, Drew teaches that the storage sleeve is capable of holding and protecting an article having a sensitive surface as claimed, where a compact disk corresponds to the article as claimed and the playing surface of the compact disk is the sensitive surface of the article as claimed. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, since Midkiff teaches that the web is electret treated so that particles are electrostatically drawn toward the web (col. 8, lines 5-32), the sensitive surface protective material taught by Midkiff protects the sensitive surface from damage caused by particles as claimed by attracting the particles to the electret treated spunbond nonwoven web, and therefore, away from the sensitive surface.

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Furthermore, Drew teaches that the storage sleeve has an open end to allow the article having the sensitive surface to be inserted into the storage sleeve as claimed and that the storage sleeve has a shape to accommodate the article having a sensitive surface as claimed (see all Figures). In regard to claim 30, Drew teaches an article having a sensitive surface protected by the storage sleeve as discussed in the rejections to claims 13 and 29 and that the article is located inside the storage sleeve as claimed (see, for example, Figure 1A, where item 4, the compact disk, is located inside the storage sleeve, and col. 3, lines 43-47).

In regard to claim 31, Midkiff teaches the sensitive surface protective material as discussed above. Midkiff fails to explicitly teach an article having a sensitive surface protected by the sensitive surface protective material where the sensitive surface of the article is in contact with the sensitive surface protective material. Drew, however, discloses a pocket wherein a compact disc (an article having a sensitive surface as claimed) is placed and the playing side (the sensitive surface of the article having a sensitive surface as claimed) of the compact disk is in contact with a protective nonwoven sheet so that the playing surface of the compact disk is protected (col. 1, lines 41-54 and 63-65, col. 2, lines 6-13 and 39-43, col. 3, lines 42-66 and Figures 1-12; col. 5, lines 15-39). Therefore, one of ordinary skill in the art would have recognized to have used the protective web of Midkiff et al. as the protective nonwoven sheet of Drew et al. since it is notoriously well known to protect a sensitive surface of an article by placing the sensitive surface of the article in contact with a sensitive surface protective material as taught by Drew.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the protective web of Midkiff et al. as the protective nonwoven sheet of Drew et al. since it is notoriously well known to protect a sensitive surface of an article by placing the sensitive surface of the article in contact with a sensitive surface protective material as taught by Drew.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Midkiff in view of the admitted prior art of Applicant (page 1, line 25-page 2, line 1).

Midkiff teaches the electret treated spunbond nonwoven protective web as discussed above. Midkiff fails to teach a stack of articles having a sensitive surface comprising the sensitive surface protecting material of Midkiff between each article in the stack. However, Applicants disclose that photographic transparencies are protected by inserting a sheet of paper between each transparency and that the sheets of paper between each transparency in a stack of transparencies protect the transparencies from dust build-up during storage (page 1, line 25-page 2, line 1). One of ordinary skill in the art would have recognized to have used the electret treated spunbond nonwoven protective web of Midkiff in place of the sheets of paper used to protect each photographic transparency in a stack of photographic transparencies as disclosed by Applicants in order to protect the photographic transparencies from dust build-up during storage to a greater degree than is possible with paper due to the fact that particles (i.e. dust) are electrostatically attracted to the electret treated spunbond nonwoven protective web of Midkiff as taught by Midkiff.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the electret treated spunbond nonwoven protective web

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of Midkiff in place of the sheets of paper used to protect each photographic transparency in a stack of photographic transparencies as disclosed by Applicants in order to protect the photographic transparencies from dust build-up during storage to a greater degree than is possible with paper due to the fact that particles (i.e. dust) are electrostatically attracted to the electret treated spunbond nonwoven protective web of Midkiff as taught by Midkiff.

(11) *Response to Argument*

Appellant's arguments regarding the 35 U.S.C. 102 rejection of claims 1-11 have been fully considered but are not persuasive. Appellant argues that the web of Midkiff is not "bonded with a pattern having continuous bonded areas defining a plurality of discrete unbonded areas" as is claimed in claim 1; however, the web of Midkiff plainly reads on the web structure claimed in Appellant's claim 1. As stated in paragraph 13 of Paper 10, the web of Midkiff has bonds at almost every fiber crossover point (col. 7, lines 55-57). The web structure where the fibers are bonded at almost every fiber crossover point reads on the claimed structure that is cited earlier in this paragraph because (1) each fiber crossover point at which the fibers are bonded is a "continuous bonded area[]", (2) each fiber crossover point at which the fibers are not bonded is a "discrete unbonded area[]", (3) even the areas along all of the fibers of the web that are not at fiber crossover points (both bonded and unbonded fiber crossover points) are "discrete unbonded areas" and (4) the bonded fiber crossover points "defin[e]" the "discrete unbonded areas" of the web of Midkiff since the "discrete unbonded areas" are all the "areas" of the web other than the bonded fiber crossover points (equivalently, the "continuous bonded areas").

Appellant argues that since the fibers are bonded at “points”, there cannot be “continuous bonded areas which surround and define the unbonded areas”, but each point itself is a continuous bonded area. Each of the bonded fiber crossover points are continuous (within each of themselves, as is required by the claim language) because a bond point is a continuous area of the web where one fiber is bonded to another (the bond points of Midkiff would be better characterized as bonded areas since the bond points in a web cannot be one-dimensional as the term “point” indicates from the mathematical sense of the term). The bond points of Midkiff do indeed define the unbonded areas for the reason discussed in point (4) of the previous paragraph. The bond points also surround the unbonded areas because, since the web of Midkiff has bonds at almost every fiber crossover point (col. 7, lines 55-57), (1) the areas along all of the fibers of the web that are not at fiber crossover points (both bonded and unbonded fiber crossover points) are surrounded by the bond points and (2) the few unbonded fiber crossover points themselves are surrounded by the bond points. Appellant argues that the bonded fiber crossover points “are not taught to be connected together”, but there is no requirement in claim 1 that the bonded areas be connected together. The structure to which Appellant refers in Appellant’s argument that the bonded areas are “not connected together into a continuous bonded area that surrounds or encircles an unbonded area” is not claimed by Appellant. Appellant claims plural “continuous bonded areas”, not a single area.

Appellant’s arguments regarding the 35 U.S.C. 103 rejection of claim 28 have been fully considered but are not persuasive. Appellant’s arguments rely entirely upon the Appellant’s arguments regarding the rejection of claims 1-11, which have been addressed above.

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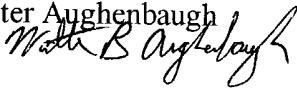
Appellant's arguments regarding the 35 U.S.C. 103 rejection of claims 13-26 and 29-31 have been fully considered but are not persuasive. Appellant again refers to Appellant's arguments regarding the rejection of claims 1-11, which have been addressed above. Appellant's statement that Drew teaches that fibers are "tack bonded together" to form the web of Drew is irrelevant because the rejection proposes using the web of Midkiff within the storage sleeve structure taught by Drew via replacement of the web of Drew with the electret treated web of Midkiff; Drew is relied upon for the storage sleeve structure, while Midkiff is relied upon for the structure of the web itself.

Therefore, Examiner respectfully submits that claims 1-11, 13-26 and 28-31 should be rejected since the scope of the claims falls within the limitations of the existing art. Thus, after considering all the evidence, it is still the position of Examiner that the rejection is appropriate.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Walter Aughenbaugh



August 19, 2004

Conferees:

Deborah Jones



Harold Pyon



HAROLD PYON
SUPERVISORY PATENT EXAMINER

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8/20/04

Ralph H. Dean, Jr.
Kimberly-Clark Worldwide, Inc.
Patent Department
401 North Lake Street
Neenah, WI 54956